



Af/ PATENT 3625

Case Docket No. ELIBER.001A

Date: April 2, 2004

Page 1

In re application of : Clarke, et al.  
Appl. No. : 09/653,095  
Filed : August 31, 2000  
For : METHODS AND  
SYSTEMS FOR A  
DYNAMIC  
NETWORKED  
COMMERCE  
ARCHITECTURE  
Examiner : Robert E. Rhode, Jr.  
Art Unit : 3625

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April 2, 2004

(Date)

Michael S. Okamoto, Reg. No. 47,831

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**GROUP 3600**

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Sir:

Transmitted herewith in triplicate is an Appellants' Brief to the Board of Patent Appeals:

- (X) Fee for filing brief in the amount of \$330 is enclosed.
- (X) If applicant has not requested a sufficient extension of time and/or has not paid any other fee in a sufficient amount to prevent the abandonment of this application, please consider this as a Request for an Extension for the required time period and/or authorization to charge our Deposit Account No. 11-1410 for any fee which may be due. Please credit any overpayment to Deposit Account No. 11-1410.
- (X) Return prepaid postcard.

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#1 Appeal Brief  
Ellis  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

4/21/04

Applicants : Clarke, et al. ) Group Art Unit: 3625  
Appl. No. : 09/653,095 )  
Filed : August 31, 2000 )  
For : METHODS AND SYSTEMS )  
FOR A DYNAMIC )  
NETWORKED COMMERCE )  
ARCHITECTURE )  
Examiner : Robert E. Rhode, Jr.

APPELLANTS' BRIEF  
PURSUANT TO 37 C.F.R. § 1.192

Board of Patent Appeals and Interferences  
US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

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**GROUP 3600**

Dear Sir:

Appellants, Applicants in the above-captioned patent application, appeal the final rejection of Claims 1-25 set forth in the final Office Action mailed on October 24, 2003. A check for the filing fee is enclosed. Please charge any additional fees that may be required now or in the future to Deposit Account No. 11-1410.

**I. REAL PARTY IN INTEREST**

The real party of interest in the present application is Interchange Corporation.

**II. RELATED APPEALS AND INTERFERENCES**

Pursuant to 37 C.F.R. § 1.192(c)(2), Appellants hereby notify the Board of Patent Appeals that Appellants, the Appellants Legal Representative, and the Assignee do not know

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of any appeals or interferences that will directly affect or be directly affected by or have any bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 1-25 are currently pending in the application, and are attached hereto as an appendix. All of the pending claims were finally rejected by the Examiner and are the subject of this appeal.

### **IV. STATUS OF AMENDMENTS**

Appellants amended Claim 4 in response to the first Office Action. No claims have been amended subsequent to the Final Office Action.

### **V. SUMMARY OF INVENTION**

The present invention relates to the use of a cascading commerce menu for assisting a user to find products for sale. One aspect of the present invention is a method of providing access to information relating to a plurality of products using a cascading commerce menu. Figure 1 (all references are to the present application unless indicated otherwise) illustrates an example of a cascading commerce menu. Reference numbers 106 and 108 of Figure 1 are examples of a first level menu and a second level menu, respectively, of the cascading commerce menu. Figure 2 also illustrates a cascading commerce menu. Reference number 206 of Figure 2 is an example of a first product category of "Computer & Software" of a first level menu. In response to a detection of a cursor over the first product category, shown in Figure 2 as "Computer & Software," a second level menu listing is provided, which includes product categories, books, components, desktop, and so forth, including another product category for "monitors," with reference number 208. In addition, Figure 2 illustrates further progressions down a cascading commerce menu.

Another aspect of the present invention includes using a cascading commerce menu and automatically generating a search request based at least in part on a customer selection of a product category within the cascading commerce menu. The selection of the product category can be used to create a complex product search string, relieving the user or

consumer from the task of manually entering product-related search terms. See page 2, lines 13-18 and page 6, lines 11-20. For example, in response to a user selection of a product category of '17" monitors' 210 on Figure 2, a product-related search can be performed by, for example, a commerce server, see page 2, line 13, and an example of the results of such a search is shown in Figure 13.

Another aspect of the invention is a method of using the cascaded commerce menu and ranking. This is described from page 11 line 9 to page 13 line 2. For example, as recited in Claim 8, the ranking of product or product source can be based on an aggregate price. Figure 3 illustrates a ranking based on an aggregate price.

Another aspect of the present invention is a method of providing access to information relating to a plurality of products and services and providing rewards at least partly in response to a customer's selection of a subset of product categories in the cascading menu. For example, a user can earn micro-credits during usage of a cascading commerce menu, and the user can use the micro-credits to make purchases or to receive discounts. See page 8, line 1 to page 9, line 9.

## **VI. ISSUES PRESENTED ON APPEAL**

The following issues are presented:

Whether Claims 1-3, 6, 7 and 25 are properly rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 6,256,028 B1 to Sanford, et al ("Sanford");

Whether Claims 4, 5, 8, and 14 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over Sanford in view of U.S. Patent No. 6,286,002 B1 to Axaopoulos, et al ("Axaopoulos");

Whether Claims 9-13, 19, and 20 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over Sanford in view of Axaopoulos and further in view of U.S. Patent No. 6,260,024 B1 to Shkedy ("Shkedy");

Whether Claims 15-18 and 22-24 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over Sanford in view of Axaopoulos and further in view of U.S. Patent No. 6,185,541 B1 to Scroggie, et al ("Scroggie"); and

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Whether Claim 21 is properly rejected under 35 U.S.C. § 103(a) as unpatentable over Sanford in view of Scroggie.

## **VII. GROUPING OF CLAIMS**

All of the rejected claims in the present application should not stand or fall together. Appellants, for purposes of this appeal only, are grouping the claims as follows:

GROUP 1: Claims 1-3, 6, 7, and 25. These claims are directed generally to a method for providing access to information relating to a plurality of products using a cascading commerce menu. A first level product category menu is provided. A position of a cursor is detected over a first product category of the first level menu. A cascading second level menu listing a set of product subcategories is then provided in response to the detection the first product category.

GROUP 2: Claims 4, 5, 14 and 18. These claims are generally directed to automatically generating a search string based on product categories. All of these claims in this group include a limitation that a search request is automatically generated in response to user interaction with the cascading commerce menu.

GROUP 3: Claims 8-13 and 19-20. These claims are directed generally to ranking. All of these claims in this group include a limitation that providers or products are ranked. For example, Claim 8 recites that providers are ranked based on an aggregate price.

GROUP 4: Claims 15-17 and 21-24. These claims are directed generally to a method providing a customer with a reward. All of these claims in this group include a limitation that the user of the cascading commerce menu is provided with a reward for using the cascading commerce menu.

Appellants believe that many of the dependent claims recite limitations that provide additional bases for patentability. However, in the interest of administrative economy and efficiency, Appellants are grouping the claims as set forth above, and as a result, are focussing on the independent claims.

### **VIII. ARGUMENT**

#### **A. EACH CLAIM GROUP IS PATENTABLY SEPARATE FROM THE OTHERS**

As indicated above, all of the claims in Group 2 require the automatic generation of a search string based on product categories. This feature of the Group 2 claims provides a separate basis for patentability over the independent claims of Groups 1 and 4 and the claims of Group 3.

As also indicated above, all of the claims of Group 3 include limitations related to ranking. This feature of Group 3 claims provides a separate basis for patentability over the independent claims of Groups 1, 2, and 4.

As also indicated above, all of the claims of Group 4 include a limitation related to rewards. This feature of Group 4 claims provides a separate basis for patentability over the independent claims of Groups 1 and 2 and the claims of Group 3.

#### **B. DISCUSSION OF REFERENCES RELIED UPON BY EXAMINER**

##### **1. U.S. Patent No. 6,256,028 B1 to Sanford, et al ("Sanford")**

Sanford discloses a dynamic site browser for a news Web site. A site browser and a datafile are assigned to the Web site by the publishers of a Web site. See Col. 5, lines 16-20. The site browser is computer code that will create a cascading menu using application program interface (API) calls to the windows-based operating system on the user's system based on the structure and contents of a datafile. See Col. 5, lines 31-34. A datafile is created for the prepared Web pages by saving the address (e.g., URL) and heading information for the prepared Web pages based on where the heading will appear in a cascading menu. The location where the heading will appear in the cascading menu is a choice made by the Web site publisher. See Col. 5, lines 41-44.

The dynamic site browser permits a user to navigate a particular Web site. It should be noted that the publisher of the Web site controls the cascading menu by controlling the contents of the datafile.

It should also be noted that Sanford teaches the efficient navigation to a Web page within the Web site, and not a cascading commerce menu with product levels. The displayed pages would be predetermined by the publisher of the Web site. Thus, the contents of the

menu and the resulting displayed pages are limited to the Web pages of the publisher of the Web site. It should be noted that, for example, one of the advantages of Appellants' invention is that it permits a user to efficiently select among a plurality of providers based on ranking, such as the ranking by aggregate price illustrated in Figure 3 of Appellants' specification. Sanford does not teach or disclose commerce, products, product sales, product rankings, product sources, shipping and the like. In fact, a careful reading of Sanford reveals that the words "product," "goods," and "commerce" are not even present in Sanford.

**2. U.S. Patent No. 6,286,002 B1 to Axaopoulos, et al ("Axaopoulos")**

Axaopoulos discloses a search engine that helps consumers find the goods and services they want. See Col. 2, lines 63-64. The system uses a modified tree search technique. The user follows branches of a tree, each branch further defining the interests of the users. See Col. 4, lines 13-15. A node in the tree can be associated with a key term (also referred to generally as a key, a key phrase, or a keyword). See Col. 6, lines 41-44. A user traverses the tree to refine the products needed by the consumer. See Col. 10, lines 51-53. A buy agent searches for a product that is associated with the keywords in the path traversed by the user. See Col. 11, line 33-34. An example of results of a search is illustrated in Figure 22 and discussed in Col. 15, lines 50-63.

It should be noted that ranking is not shown in Figure 22. Figure 22 illustrates a listing of 2 automobiles with 2 different prices. Appellants submit that a ranking cannot be inferred from the mere listing of 2 items of different price. With two items of different price, one item will necessarily be more expensive than the other. It should be apparent that in a list with only two items, an arbitrary display of ordering is not distinguishable from a ranked ordering.

**3. U.S. Patent No. 6,260,024 to Shkedy ("Shkedy")**

Shkedy discloses a system with a central controller for facilitating buyer/seller transactions. The system permits buyers to aggregate their orders into a large pooled purchase order, see Col. 2 lines 60-62. This provides an individual buyer with a collective bargaining power usually reserved for large retailers or corporations that regularly exercise

buying clout by virtue of their size. By aggregating individual purchase orders into a single aggregate purchase order, each individual participant will receive more favorable purchasing terms than what could be achieved by acting independently, see Col. 3, lines 58-65.

Shkedy discloses that the optimization of the best bid may be found by using an industrial type of optimization software package that uses inventory planning, transportation scheduling, shipping charges, taxes, the cost of the goods etc. One such package is ProfitPro manufactured by Scientific Management Software, Inc., see Col. 17, lines 55-60. Shkedy does not teach or disclose the addition of a shipping cost associated with providing a good from a “first provider to a first consumer.”

4. U.S. Patent No. 6,185,541 to Scroggie, et al (“Scroggie”)

Scroggie disclosing a system and method for delivering purchasing incentives. Scroggie’s system describes the efficient electronic distributions of coupons. A customer logs in to a central site to communicate with the central site. See Col. 1, lines 51-54. In response to the customer selection data, the method performs the steps of generating a purchasing incentive containing (in encoded form) the identify of the retailer designated by the customer and the identify of the customer; and transmitting at least one incentive to the customer over the communications network, for subsequent printing by the customer.

The system can also transmit meal planning information, such as a list of recipes, can receive a selection of an item such as a recipe, and then transmit back to the customer a shopping list with ingredient products. At least one purchase incentive (coupon) pertaining to the selected recipe can be provided, thereby providing a discount on a particular item. See Col. 2 lines 21-28.

Scroggie does not show the earnings of credits or rewards. A “reward” is something that is earned by a consumer by, for example, click throughs, searches, and referrals, as explained in Appellants’ specification on page 19, lines 26-28. Scroggie only teaches coupons. A coupon is not something that is “earned,” but rather, given away to induce an individual to make a purchase.



**C. DISCUSSION OF THE ISSUES ON APPEAL**

For the reasons set forth below, Appellants respectfully submit that the teaching of Sanford patent do not render the invention as defined by Claims 1-3, 6, 7 and 25 unpatentable; the teachings of Sanford and Axaopoulos do not render the invention as defined by Claims 4, 5, 8, and 14 obvious; the teachings of Sanford, Axaopoulos, and Shkedy do not render the invention as defined by Claims 9-13, 19, and 20 obvious; and the teachings of Sanford, Axaopoulos, and Scroggie do not render the invention as defined by Claims 15-18 and 22-24 obvious. Copies of the cited cases are enclosed.

**1. The applied reference does not teach does not teach every element of any claim in Group 1**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Each independent claim in Group 1 is discussed separately below.

Claim 1

With respect to independent Claim 1, the Sanford reference does not teach the following element “a cascading commerce menu” as recited in the preamble. Further, Sanford does not teach the element “providing a first level menu listing a first set of product categories.” In addition, Sanford does not teach the element “detecting a position of a cursor over a first product category listed in said first set of product categories. Also, Sanford does not teach the element “providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position.”

In rejecting Claim 1, the Examiner states that Sanford’s Abstract and Figure 7 teach the “cascading commerce menu” and “providing a first level menu listing a first set of product categories.” Appellants respectfully disagree with this characterization. Sanford’s Abstract describes a cascading menu for access to Web pages of a news Web site. Figure 7

of Sanford illustrates Sanford's cascading menu for a news Web site. There is no mention of products, goods, or commerce in the Abstract or in Figure 7.

The Examiner also states that Sanford, at Col. 7 lines 11-13 and Figure 7, teaches "detecting a position of a cursor over a first product category listed in said first set of product categories" and also teaches "providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position." Appellants respectfully disagree with this characterization. As previously discussed, Sanford does not discuss products, goods, or commerce. Further, Figure 7 of Sanford only illustrates the use of a cascading menu in connection with a news Web site. In addition, Sanford at Col. 7 lines 11-13 merely states "[t]he first and second interactive components are both activated when a mouse controlled cursor overlays the area occupied by the line item." Nowhere does Sanford indicate that the cascading menu is dedicated to a commerce application. Rather, Sanford teaches a cascading menu that is downloaded in connection with a news Web site.

Thus, Sanford does not teach and is not concerned with "a cascading commerce menu;" "providing a first level menu listing a first set of product categories;" "detecting a position of a cursor over a first product category listed in said first set of product categories;" "providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position."

#### Claim 25

The Examiner rejected independent Claim 25 together with Claim 1. Appellants respectfully submit that the Sanford reference does not teach any of the limitations "a cascading commerce menu" as recited in the preamble, "means for providing a first level menu listing a first set of product categories," "means for detecting a position of a cursor over a first product category listed in said first set of product categories," and "means for providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position."

As discussed earlier in connection with the Examiner's rejection of Claim 1, Appellants submit that Sanford's Abstract and Figure 7 teach a cascading menu for a news

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Web site and not a “cascading commerce menu” and a “means for providing a first level menu listing a first set of product categories” as asserted by the Examiner.

Also as discussed earlier in connection with the Examiner’s rejection of Claim 1, Appellants submit that Sanford, at Col. 7 lines 11-13 and Figure 7, does not teach a “means for detecting a position of a cursor over a first product category listed in said first set of product categories,” or a “means for providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position,” as asserted by the Examiner. Rather, Sanford teaches a cascading commerce menu for a news Web site.

Because Claims 1 and 25 include limitations that are not described by the applied art, the novelty rejection of the Group 1 claims is improper and should be withdrawn.

**2. The applied references do not disclose or suggest every limitation of any claim in Group 2**

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03. Claims 4, 5, and 14 in Group 2 were rejected over a combination of Sanford and Axaopoulos. Claim 18, which depends from Claim 14, was rejected over a combination of Sanford, Axaopoulos, and Scroggie. In this case, the combination of Sanford and Axaopoulos, and the combination of Sanford, Axaopoulos, and Scroggie fail to establish prima facie obviousness of Claims 4, 5, and 14, and Claim 18, respectively. Independent claim 14 from Group 2 is discussed below.

Claim 14

With respect to independent Claim 14, neither Sanford nor Axaopoulos teaches or suggests the limitations “a cascading commerce menu” as recited in the preamble, “providing a first level menu including a set of high-level product categories,” “detecting a customer selection of a high-level product category from said set of high-level product categories,” “providing a cascading second level menu including a set of relatively narrower product categories related to said high-level product category in response to said customer selection,” “detecting a customer selection of a relatively narrower product category from said set of

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relatively narrower product categories.” The Examiner states that Sanford teaches these limitations, and Appellants disagree with the Examiner’s characterization of Sanford as discussed earlier in connection with the Examiner’s rejection of Claim 1. Sanford is directed to a news Web site menu and is not concerned with product categories.

Axaopoulus also does not discuss a cascading commerce menu, nor a cascading menu of any kind.

Appellants respectfully submit that because the combination of Sanford and Axaopoulus does not teach or suggest the limitations as asserted by the Examiner, all of the claim limitations are not taught or suggested by the applied prior art. Rather than teach a cascading commerce menu, Sanford teaches a cascading menu for a news Web site. Because Claim 14 includes limitations that are not disclosed or suggested by the applied art, the obviousness rejection of the Group 2 claims is improper and should be withdrawn.

**3. The applied references do not disclose or suggest every limitation of any claim in Group 3**

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03. Group 3 includes Claims 8-13 and 19-20. These claims are directed generally to ranking. Claim 8 was rejected over a combination of Sanford and Axaopoulos. Claims 9-13 and 19-20 were rejected over a combination of Sanford, Axaopoulos, and Shkedy. All of these claims in this group include an element that providers or products are ranked. There are no independent claims in Group 3. Claims 8 and 9 are separately discussed below.

Claim 8

With respect to Claim 8, which is a dependent claim of Claim 1, neither Sanford nor Axaopoulos teaches or suggests the limitations “a cascading commerce menu” as recited in the preamble of Claim 1, “providing a first level menu listing a first set of product categories,” “detecting a position of a cursor over a first product category listed in said first set of product categories,” and “providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of

said cursor position,” as recited in Claim 1. As Appellants discussed earlier in connection with Group 1, Sanford does not teach or suggest the limitations of Claim 1, from which Claim 8 depends.

Further, neither Sanford nor Axaopoulos teaches or suggests the limitation “ranking providers based on an aggregate price of an item available from the providers” as recited in the preamble of Claim 8. The Examiner acknowledges that Sanford does not teach “ranking providers based on an aggregate price of an item available from the providers” as indicated on page 9 of the Final Office Action. The Examiner states that Axaopoulos at Figure 22 teaches ranking. Appellants respectfully disagree with this characterization of Axaopoulos.

Figure 22 of Axaopoulos does not even disclose aggregate costs. Further, a careful reading of Axaopoulos fails to disclose any mention of ranking. On page 5 of the Final Office Action, the Examiner states that “Axaopoulos does provide a ranking based on aggregated price and further it is implicit that an individual as well as a dealer would have included in all cost.” Appellants disagree. For example, Figure 22 illustrates an offer price of \$18,000 from the individual. This offer price of \$18,000 exactly matches with the “offer price” shown in Figure 20. There is no mention of delivery costs, automobile registration fees, sales taxes, and the like, which would typically be involved in an automobile transaction. Moreover, it should be recognized that registration fees and sales taxes are typically not collected by an individual seller of an automobile and would thus not be included in the “Offer Price” field of Figure 20. Accordingly, Appellants respectfully submit that Figure 22 does not show aggregate costs.

In addition, Figure 22 of Axaopoulos does not show a ranking. Figure 22 illustrates a listing of 2 automobiles with 2 different prices. Appellants submit that a ranking cannot be inferred from the mere listing of 2 items of different price. With two items of different price, one item will necessarily be more expensive than the other. It should be apparent that in a list with only two items, an arbitrary display of ordering is not distinguishable from a ranked ordering.

Claim 9

With respect to Claim 9, which is a dependent claim of Claim 8, which in turn is a dependent claim of Claim 1, the combination of Sanford, Axaopoulos, and Shkedy do not teach or suggest the additional limitation in Claim 9 of “wherein said first additional cost is a shipping cost associated with the provision of said item from said first provider, and said second additional cost is a shipping cost associated with the provision of said item from said second provider.”

As discussed earlier in connection with Group 1, Sanford does not teach or disclose a cascading commerce menu. As discussed earlier in connection with Claim 8 of this Group, Axaopoulos does not teach or disclose ranking of aggregate costs.

The Examiner acknowledges on page 12 of the Final Office Action that the “combination of Sanford and Axaopoulos does not specifically disclose and teach” the limitation of Claim 9. The Examiner states that Shkedy at Col. 17, lines 55-59 teaches “wherein said first additional cost is a shipping cost...” Appellants disagree with this characterization. Shkedy’s system permits individual buyers to aggregate their orders into a large pooled purchase order, see Col. 2 lines 60-62. Shkedy teaches aggregating individual purchase orders into a single aggregate purchase order, so that each individual participant will receive more favorable purchasing terms than what could be achieved by acting independently, see Col. 3, lines 58-65.

Accordingly, any shipping costs taken into account by Shkedy to calculate the “best bid” as described in Col. 17, lines 55-60 relate to the shipping costs for the single aggregate purchase order, and not for an individual, such as “a first additional cost associated with providing the item by said first provider to a first consumer,” as recited in Claim 8, where the “first additional cost is a shipping cost associated with the provision of said item from said first provider” as recited in Claim 9.

Because Claims 8 and 9 include limitations that are not described by the applied art, the obviousness rejection of the Group 3 claims is improper and should be withdrawn.

**4. The applied references do not disclose or suggest every limitation of any claim in Group 4**

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03. The independent claim in Group 4, Claim 21, recites limitations that are not disclosed or suggested by either Sanford or Scroggie. Claim 21, the only independent claim in Group 4, is discussed below.

Claim 21

With respect to Claim 21, neither Sanford nor Scroggie teach or suggest “detecting a customer selection of a product category on a first level menu of said cascading menus,” “causing a display of a cascading second level menu including a subset of product categories within the selected product category, wherein the subset contains one or more product categories,” “detecting a customer selection of a first of said subset of product categories,” and “providing a reward to the customer at least partly in response to the customer’s selection of said first subset of product categories.”

Sanford does not teach or suggest “detecting a customer selection of a product category on a first level menu of said cascading menus,” “causing a display of a cascading second level menu including a subset of product categories within the selected product category, wherein the subset contains one or more product categories,” “detecting a customer selection of a first of said subset of product categories,” as asserted by the Examiner. As discussed earlier in connection with Group 1, Appellants respectfully assert that Sanford teaches a cascading menu for a news Web site and not for products.

On page 17 of the Final Office Action, the Examiner acknowledges that Sanford does not teach “providing a reward to the customer at least partly in response to the customer’s selection of said first subset of product categories.” The Examiner asserts that Scroggie at Col. 3, lines 12-14 teaches the reward. Appellants respectfully disagree.

Scroggie teaches purchasing incentives or coupons. Such purchasing incentives or coupons differ fundamentally from rewards. A coupon is a discount on a specific product. As recited by Scroggie, “[i]nformation encoded onto each coupon will include the product code, the consumer’s household id., an offer code, an expiration date, a serial number, a valid

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supermarket id. and Internet consumer's name." See Col. 10, lines 12-15. A coupon is generally not something that is "earned," but rather, given away to induce an individual to make a purchase for a specific product. By contrast, a "reward" is something that is earned by a consumer by, for example, click throughs, searches, and referrals, as explained in Appellants' specification on page 19, lines 26-28.

Because Claim 21 includes limitations that are not described by the applied art, the obviousness rejection of the Group 4 claims is improper and should be withdrawn.

**4. The Examiner has not identified a valid suggestion for combining Sanford and Axaopoulos; Sanford and Scroggie; Sanford, Axaopoulos and Scroggie; and Sanford, Axaopoulos, and Shkedy, and no such suggestion exists in the references.**

Appellants further respectfully submit that in rejecting the claims of Groups 2-4, the Examiner has failed to identify a legally sufficient suggestion or motivation to combine or modify one or more of Sanford, Axaopoulos, Scroggie, and Shkedy as will be discussed further separately below. Appellants further submit that no such suggestion or motivation exists within these references.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." See, e.g., *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of motivation to combine. *Id.*

#### Combination of Sanford and Axaopoulos

The Examiner asserts that it would have been obvious to combine the method of Sanford with the method of Axaopoulos "in order to ease the burden on the shopper to search the web for items highlighted/selected and being provided with ranked, multiple bidders.



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Thereby increasing their level of satisfaction as well as increasing the probability that they will return in the future to the web site for additional shopping needs as well as recommend the site to others.” See page 11, lines 10-15 of the Final Office Action. Appellants respectfully submit that the Examiner’s statement is merely a broad, conclusory statement regarding the benefits of comparative shopping in general, and does not identify a suggestion or motivation to combine the references.

By contrast, Appellants note that Sanford is not concerned with products, selling products, ranking products, and categorizing products. Further, Sanford does not teach or disclose a cascaded commerce menu, but rather, a cascaded menu for a news Web site. Sanford does not even teach combining various news stories from various news Web sites into the cascaded menu, let alone comparative shopping among multiple vendors. Further, Axaopoulos does not teach or suggest the desirability of a combination with any form of cascaded menu. Thus, there would be no motivation to modify Sanford with the teachings of Axaopoulos.

Further, there is no motivation described in Axaopoulos to modify Sanford to provide a commerce menu.

The Examiner thus has not met the burden of identifying a clear and particular motivation or suggestion to combine Sanford and Axaopoulos, and no such motivation exists.

#### Combination of Sanford and Scroggie

The Examiner asserts that it would have been obvious to combine the method of Sanford with the method of Scroggie “in order to provide the customer a reward or credit at last partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement. In that regard, the on line shopper is incented [sic] to continue using the web site more frequently for purchases in order to capture and use these cost reduction benefits – and too [sic] increasing the satisfaction of the customer as well as increasing their frequency of use of the online site for shopping.” See page 18, lines 2-8 of the Final Office Action. Appellants respectfully submit that the Examiner’s statement is merely a broad, conclusory statement regarding the benefits

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of comparative shopping in general, and does not identify a suggestion or motivation to combine the references.

As previously described, Sanford is not concerned with products, selling products, ranking products, and categorizing products. Further, Sanford does not teach or describe a cascading commerce menu and it accordingly would not be obvious to combine Sanford with a method of providing a reward or credit in connection with commerce. Moreover, Scroggie does not describe providing a reward or credit in connection with the use of a cascading menu, and moreover does not suggest providing a reward or credit in connection with anything. For example, a user of Scroggie's system does not earn reward points for using Scroggie's system. Furthermore, a user of Scroggie's system is not actually engaged in online shopping. Rather, a user of Scroggie's system uses the online system to receive a coupon, which is then used in a retail store. See Abstract. Thus, there is no incentive in Scroggie to use Scroggie's system frequently.

Further, there is no motivation described in Scroggie to modify Sanford to provide a commerce menu.

The Examiner thus has not met the burden of identifying a clear and particular motivation or suggestion to combine Sanford and Scroggie or to modify Sanford, and no such motivation exists.

#### Combination of Sanford, Axaopoulos and Scroggie

The Examiner asserts that it would have been obvious to combine the method of Sanford with the method of Axaopoulos and with the method of Scroggie "to enable the capability of providing the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement. In that regard, the on line shopper is incented [sic] to continue using the web site more frequently for purchases in order to capture and use these cost reduction benefits - and too [sic] increasing the satisfaction of the customer as well as increasing their frequency of use in shopping." See page 16, line 16 to page 17, line 4 of the Final Office Action. Appellants respectfully submit that the Examiner's statement is merely

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a broad, conclusory statement regarding the benefits of online shopping, and does not identify a suggestion or motivation to combine the references.

As previously described, Sanford is not concerned with products, selling products, ranking products, and categorizing products. Further, Sanford does not teach or describe a cascading commerce menu and it accordingly would not be obvious to combine Sanford with a method of selling products online. Also, as explained earlier, Scroggie does not teach an online shopping system, but rather, an online system for distributing coupons for use in retail stores. Thus, it would not be obvious to combine an online shopping system as taught by Axaopoulos with a cascading menu for a news Web site as taught by Sanford and an online system for distributing retail store coupons as taught by Scroggie. In fact, the use of coupons in retail stores teaches away from a combination including online shopping.

Accordingly, there is no motivation described in Axaopoulos or in Scroggie to combine with or modify Sanford in the manner suggested by the Examiner.

The Examiner thus has not met the burden of identifying a clear and particular motivation or suggestion to combine Sanford, Axaopoulos, and Scroggie, and no such motivation exists.

#### Combination of Sanford, Axaopoulos, and Shkedy

The Examiner asserts that it would have been obvious to combine the method of Sanford with the method of Axaopoulos and with the method of Shkedy “in order to provide an even more robust capability in shopping for, and providing detailed information from several providers on requested products.” See page 14, lines 8-10 of the Final Office Action. Appellants respectfully submit that the Examiner’s statement is merely a broad, conclusory statement regarding the benefits of online shopping, and does not identify a suggestion or motivation to combine the references.

As previously described, Sanford is not concerned with products, selling products, ranking products, and categorizing products. Further, Sanford does not teach or describe a cascading commerce menu and it accordingly would not be obvious to combine Sanford with a method of selling products. In contrast to the Examiner’s assertion that a combination with Axaopoulos and Shkedy would result in “providing detailed information from several

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providers,” Appellants note that Sanford does not even teach or suggest a combination with several providers of news sources, let alone products.

Moreover, in contrast to the Examiner’s assertion that the combination would permit “providing detailed information from several providers on requested products,” Shkedy states that “it is yet another object of the present invention to allow either buyers or sellers to remain anonymous...” see Col. 3, lines 16-17 and “sellers may also want to keep their identify a secret.” See Col. 25, lines 8-9.

Furthermore, rather than teach a technique of ranking providers for products, Shkedy teaches a system that permits buyers to aggregate their orders into a large pooled purchase order, see Col. 2 lines 60-62, in order to provide collective bargaining power so that “each individual participant will receive more favorable purchasing terms than what could be achieved by acting independently,” see Col. 3, lines 58-65. This implies a lack of control by an individual acting independently, which teaches away from the purpose of displaying providers to a user in a ranked list.

Thus, it would not be obvious to combine an online shopping system as taught by Axaopoulos with a cascading menu for a news Web site as taught by Sanford and pooled purchasing system for commodities as taught by Shkedy. In fact, the lack of individual control over the pooled purchasing system for commodities taught by Shkedy teaches away from the purpose of displaying a listing of products as displayed in Axaopoulos and further teaches away from an individual purchase of a specific good, such as the purchase of a used car, which for practical purposes cannot be purchased in a pool as would be suggested by Shkedy.

Further, there is no motivation described in Axaopoulos or in Shkedy to modify a cascading menu Sanford to a commerce menu.

The Examiner thus has not met the burden of identifying a clear and particular motivation or suggestion to combine Sanford, Axaopoulos, and Shkedy.

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**IX. CONCLUSION**

For the reasons set forth above, Appellants submit that the rejections of Claims 1-25 over Sanford, Axaopoulos, Shkedy, and or Scroggie is improper, and requests that the rejections be reversed.

Respectfully submitted,

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APPENDIX – PENDING CLAIMS

1. A method of providing access to information relating to a plurality of products using a cascading commerce menu, comprising:

providing a first level menu listing a first set of product categories;

detecting a position of a cursor over a first product category listed in said first set of product categories; and

providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position.

2. The method as defined in Claim 1, wherein said cascading menu is stored on a client computer.

3. The method as defined in Claim 1, wherein at least one of said listed first set of product categories provides a link over the Internet to a commerce site.

4. The method as defined in Claim 1, further comprising automatically generating a search string based on said first product category and said first product subcategory.

5. The method as defined in Claim 4, further comprising providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string.

6. The method as defined in Claim 1, wherein the cascading menu is dynamically generated from text, and where the text is stored on a client computer.

7. The method as defined in Claim 6, wherein the dynamically generated cascading menu is updated, further comprising:

receiving an indication of a version of the text stored on the client computer;  
transmitting changes to be applied to the text stored on the client computer;  
updating the text stored on the client computer using the transmitted changes;

and

dynamically generating the cascading menu from the updated text.

8. The method as defined in Claim 1, further including ranking providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising:

receiving a first item price for said item from a first provider;

receiving a first additional cost associated with providing the item by said first provider to a first consumer;

receiving a second item price for said item from a second provider;

receiving a second additional cost associated with providing the item by said second provider to said first consumer; and

ranking said first provider and said second provider based on at least said first item price, said second item price, said first additional cost, and said second additional cost.

9. The method as defined in Claim 8, wherein said first additional cost is a shipping cost associated with the provision of said item from said first provider, and said second additional cost is a shipping cost associated with the provision of said item from said second provider.

10. The method as defined in Claim 8, wherein said first additional cost is a tax associated with the provision of said item from said first provider, and said second additional cost is a tax associated with the provision of said item from said second provider.

11. The method as defined in Claim 8, wherein said first additional cost is an insurance cost associated with the provision of said item from said first provider, and said second additional cost is an insurance cost associated with the provision of said item from said second provider.

12. The method as defined in Claim 8, wherein an addition of said second item price and said second additional cost is lower than an addition of said first item price and said first additional cost, and where said second provider is ranked higher than said first provider.

13. The method as defined in Claim 12, further comprising receiving a bid from said first provider to lower at least one of said item price and said first additional cost to thereby improve the first provider's ranking.

14. A method of providing access to information relating to a plurality of products using a cascading commerce menu, comprising:

providing a first level menu including a set of high-level product categories;

detecting a customer selection of a high-level product category from said set of high-level product categories;

providing a cascading second level menu including a set of relatively narrower product categories related to said high-level product category in response to said customer selection;

detecting a customer selection of a relatively narrower product category from said set of relatively narrower product categories;



automatically generating a search request based at least in part on said customer selection of said relatively narrower product category; and

providing the customer with information on products related to said selected relatively narrower product category at least partly in response to said search request.

15. The method as defined in Claim 14, further comprising providing the customer a reward at least partly in response to using the cascading commerce menu.

16. The method as defined in Claim 15, wherein the reward is a credit.

17. The method as defined in Claim 14, further comprising providing the customer a reward in response to the customer purchasing at least one product associated with the selected relatively narrower product category.

18. The method as defined in Claim 14, further comprising providing an advertisement on at least one of said first level menu and said cascading second level menu.

19. The method as defined in Claim 14, wherein said information on products includes a ranked list of said products.

20. The method as defined in Claim 19, wherein the ranking is modified based at least in part on a bid from at least a first provider of one of said products in the ranked list.

21. A method of providing access to information relating to a plurality of products and services and providing user rewards, comprising:

downloading cascading menus to a client computer;

detecting a customer selection of a product category on a first level menu of said cascading menus;

causing a display of a cascading second level menu including a subset of product categories within the selected product category, wherein the subset contains one or more product categories;

detecting a customer selection of a first of said subset of product categories;

and

providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories.

22. The method as defined in Claim 21, further comprising causing the display of an amount of the reward associated with a selection of a first subset of product categories.

23. The method as defined in Claim 21, further comprising causing the display of the total rewards earned by the customer.

24. The method as defined in Claim 21, further comprising:

providing a referral award in response to the customer causing others to download said cascading menus; and

causing the display of the referral reward amounts earned by the customer.

25. A system that provides access to information relating to a plurality of products using a cascading commerce menu, the system comprising:

means for providing a first level menu listing a first set of product categories;

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means for detecting a position of a cursor over a first product category listed in said first set of product categories; and

means for providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position.

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